UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,433	11/13/2000	Jeff Stewart	MIME-0003	4323

23550   7590   04/29/2011
HOFFMAN WARNICK LLC
75 STATE STREET
14TH FLOOR
ALBANY, NY 12207

EXAMINER
BASEHOAR, ADAM L

ART UNIT	PAPER NUMBER
2178	

NOTIFICATION DATE	DELIVERY MODE
04/29/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/709,433
Filing Date: November 13, 2000
Appellant(s): STEWART ET AL.

John W. LaBatt
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/04/11 appealing from the Office action mailed

06/22/10.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by

name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to

the examiner which may be related to, directly affect or be directly affected by or have a bearing

on the Board's decision in the pending appeal:

This application (09/709,433) was previously appealed to the BPAI (Appeal 2007-3345)

and a decision was rendered by the Board on June 16, 2008.

An appeal for related application, U.S. Application No. 10/668,701 is currently pending

with the BPAI (Appeal 2010-009627).

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 12-16, 20-27, and 31-43 are currently pending.

Claims 12-16, 20-27, and 31-43 are currently rejected and form the basis for the appeal.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments

after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in

the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to

be reviewed on appeal. Every ground of rejection set forth in the Office action from which the

appeal is taken (as modified by any advisory actions) is being maintained by the examiner except

for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW

GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the

Appendix to the appellant's brief.

(8) Evidence Relied Upon

| 6,134,568 | TONKIN | 10-2000 |
| 6,615,234 | ADAMSKE et al. | 10-2003 |

Konica Minolta, "QMS Printing Notes for Windows Applications," published June 20, 1995,

pages 1-5

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 41 remains rejected under 35 U.S.C. 102(e) as being anticipated by Tonkin (US Patent Number 6,134,568, filed October 30, 1998).

Regarding dependent claim 41, Tonkin discloses a preview area for displaying a preview of a configured copy of a document wherein the preview is based on a print file and configuration information for the document which includes at least one printing option and defines how to assemble a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). Tonkin discloses a navigation area that enables a user to select a portion of the preview displayed in the preview area, and a estimate area for displaying the price estimate for the configured copy based on the print file and configuration information (column 12, line 23-column 13, line 51 of Tonkin). Tonkin also discloses a configuration area which allows the user to alter the configuration information, which is automatically reflected in the preview of the document (column 7, lines 11-46 of Tonkin).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 37, 38, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Adamske et al. (US Patent Number 6,615,234, filed on May 11, 1999).

Regarding independent claim 37, Adamske discloses a method in which a user uses

software on a client device to generate a print file by requesting to generate it which is identified

by a unique identifier (the file name) and uploads it to a server or a print file may be generated

on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of

Adamske). Adamske discloses a method in which a user interface is generated that may be web

based (on the server) (column 2, lines 4-60 of Adamske). The interface (configuration graphical

user interface) provides a printing options section that allows a user at the client device to

provide configuration information including finishing and binding options that define how to

assemble the printed copies (column 7, lines 16-56 of Adamske). The interface is provided to

the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies are

printed and assembled in accordance with the configuration information (column 5, line 64-

column 7, line 56 of Adamske).

Regarding independent claim 38, Adamske discloses a method in which a user uses

software on a client device to generate a print file by requesting to generate it which is identified

by a unique identifier (the file name) and uploads it to a server or a print file may be generated

on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of

Adamske). Adamske discloses a method in which a user interface is generated that may be web

based (on the server) (column 2, lines 4-60 of Adamske). The interface (configuration graphical

user interface) provides a printing options section that allows a user to provide configuration

information including finishing and binding options that define how to assemble the printed

copies (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet

for display (column 2, lines 4-60 of Adamske). A plurality of copies are printed and assembled

in accordance with the configuration information (column 5, line 64-column 7, line 56 of

Adamske).

Regarding dependent claim 40, Adamske discloses a method in which a print drive is

installed on the client in order to generate the print file (column 5, line 64-column 7, line 15 of

Adamske). Adamske discloses a method in which a print driver is installed on the client and a

print file is generated using the print driver, at which point the print file is uploaded to the server

(column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which the

print driver necessary is automatically selected (column 5, line 64-column 7, line 15 of

Adamske). Adamske does not disclose a method in which the print driver is listed. It would

have been obvious to one of ordinary skill in the art at the time the invention was made to have

allowed to have listed the print driver of Adamske because it would have allowed the user to see

the format type the print file would be in.

Claims 12-16, 20-27, 31-36, 39, 42 and 43 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Adamske et al. (US Patent Number 6,615,234, filed on May 11, 1999) in view

of Tonkin (US Patent Number 6,134,568, filed October 30, 1998).

Regarding independent claim 12 and dependent claims 32 and 33, Adamske discloses

a method in which a user uses software on a client device to generate a print file based on a

document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The user then

uploads the print file to the server, this print file (PostScript) being capable of being directly

printed by a printer (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a

method in which a user interface (configuration wizard) is generated that may be web based (on

the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a

printing options section that allows a user to provide configuration information (i.e. style

options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the

Internet for display (column 2, lines 4-60 of Adamske). Adamske discloses that the user is

prompted to both configure and preview the copy of the document in the browser (column 6, line

58-column 7, line 15 of Adamske). Adamske does not directly disclose in this embodiment that

a preview is generated by the server and provided to the user based on the print file that was

uploaded. However, Adamske discloses an alternate method in which the server generates a

preview based on the print file and the configuration information and provides that preview to

the user for display at the client device (column 5, line 64-column 7, line 15 of Adamske). It

would have been obvious to one of ordinary skill in the art to combine the two methods of

Adamske because it would have allowed the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information

obtained before the preview is generated contains finishing and binding (bound copy) options

which the preview is based on. However, Tonkin discloses that a print preview of a document is

generated based on configuration information which includes binding and finishing options for a

printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to

have combined the teachings of Adamske with the teachings of Tonkin because it would have

allowed a review of what the fully assembled document would like to help avoid any

miscommunications between the author and the assembler.

Regarding dependent claim 13, Adamske discloses a method in which a print driver is

installed on the client in order to generate the print file (column 5, line 64-column 7, line 15 of

Adamske).

Regarding dependent claim 14, Adamske discloses a method in which a print driver is

installed on the client and a print file is generated using the print driver, at which point the print

file is uploaded to the server (column 5, line 64-column 7, line 15 of Adamske). Adamske

discloses a method in which the print driver necessary is automatically selected (column 5, line

64-column 7, line 15 of Adamske). Adamske does not disclose a method in which the print

driver is listed. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have allowed to have listed the print driver of Adamske because it would

have allowed the user to see the format type the print file would be in.

Regarding dependent claim 15, Adamske discloses a method in which a user interface

is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The

interface provides a preview section and a printing options section that allows a user to provide

configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface

is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske).

Regarding dependent claim 16, Adamske discloses a method in which styles and

printing options for the document are obtained and shown via the preview, which is then

provided to the client (column 5, line 64-column 7, line 56 of Adamske).

    Regarding independent claim 20 and dependent claims 21-23, the claims incorporate

substantially similar subject matter as claims 12-15. Thus, the claims are rejected along the same

rationale as claims 12-15.

    Regarding independent claim 24, Adamske discloses a method in which a user uses

software on a client device to generate a print file based on a document and a print driver

(column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the

server, this print file (PostScript) being capable of being directly printed by a printer (column 5,

line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is

generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The

interface provides a preview section printing options section that allows a user to provide

configuration information including finishing and binding options that define how to assemble

the printed copies (column 7, lines 16-56 of Adamske). Adamske discloses that the user is

prompted to both configure and preview the copy of the document in the browser (column 6, line

58-column 7, line 15 of Adamske). The interface is provided to the user via the Internet for

display (column 2, lines 4-60 of Adamske). A plurality of copies are printed and assembled in

accordance with the configuration information (column 5, line 64-column 7, line 56 of

Adamske). Adamske does not directly disclose in this embodiment that a preview is generated

by the server and provided to the user based on the print file that was uploaded. However,

Adamske discloses an alternate method in which the server generates a preview based on the

print file and the configuration information and provides that preview to the user for display at

the client device (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious

to one of ordinary skill in the art to combine the two methods of Adamske because it would have

allowed the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information

obtained before the preview is generated contains finishing and binding (bound copy) options

which the preview is based on. However, Tonkin discloses that a print preview of a document is

generated based on configuration information which includes binding and finishing options for a

printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to

have combined the teachings of Adamske with the teachings of Tonkin because it would have

allowed a review of what the fully assembled document would like to help avoid any

miscommunications between the author and the assembler.

Regarding dependent claim 25, Adamske discloses a method in which a user uses

software on a client device to generate a print file and uploads it to a server or a print file may be

generated on a server based on a document and a print driver (column 5, line 64-column 7, line

15 of Adamske). Adamske discloses a method in which a user interface is generated that may be

web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview

section and a printing options section that allows a user to provide configuration information (i.e.

style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the

Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies is printed in

accordance with a plurality of addresses that are obtained from the user (column 5, line 64-

column 7, line 15 of Adamske). A coversheet and shipping label (memo) is customized for each

address and recipient is printed; at point all parts are delivered to the delivery addresses provided

by the client (column 7, lines 16-56 of Adamske).

Regarding dependent claim 26, Adamske discloses a method in which payment

information is obtained for the copy and the payment is processed using that information

(column 6, line 58-column 7, line 15 of Adamske).

Regarding dependent claim 27, Adamske discloses a method in which the print driver

generates the print file and an upload manager communicates the file to the server (column 5,

line 64-column 7, line 15 of Adamske).

Regarding independent claim 31, Adamske discloses a method in which a user uses

software on a client device to generate a print file based on a document and a print driver

(column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the

server, this print file (PostScript) being capable of being directly printed by a printer (column 5,

line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface

(configuration wizard) is generated that may be web based (on the server) (column 2, lines 4-60

of Adamske). The interface provides a preview section and a printing options section that allows

a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of

Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60

of Adamske). Adamske discloses that the user is prompted to both configure and preview the

copy of the document in the browser (column 6, line 58-column 7, line 15 of Adamske).

Adamske does not directly disclose in this embodiment that a preview is generated by the server

and provided to the user based on the print file that was uploaded. However, Adamske discloses

an alternate method in which the server generates a preview based on the print file and the

configuration information and provides that preview to the user for display at the client device

(column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of

ordinary skill in the art to combine the two methods of Adamske because it would have allowed

the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information

obtained before the preview is generated contains finishing and binding (bound copy) options

which the preview is based on. However, Tonkin discloses that a print preview of a document is

generated based on configuration information which includes binding and finishing options for a

printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to

have combined the teachings of Adamske with the teachings of Tonkin because it would have

allowed a review of what the fully assembled document would like to help avoid any

miscommunications between the author and the assembler.

Regarding dependent claim 34, Adamske discloses a method in which a user uses

software on a client device to generate a print file based on a document and a print driver

(column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the

server, this print file (PostScript) being capable of being directly printed by a printer (column 5,

line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface

(configuration wizard) is generated that may be web based (on the server) (column 2, lines 4-60

of Adamske). The interface provides a preview section and a printing options section that allows

a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of

Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60

of Adamske). Adamske discloses that the user is prompted to both configure and preview the

copy of the document in the browser (column 6, line 58-column 7, line 15 of Adamske).

Adamske does not directly disclose in this embodiment that a preview is generated by the server

and provided to the user based on the print file that was uploaded. However, Adamske discloses

an alternate method in which the server generates a preview based on the print file and the

configuration information and provides that preview to the user for display at the client device

(column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of

ordinary skill in the art to combine the two methods of Adamske because it would have allowed

the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information

obtained before the preview is generated contains finishing and binding (bound copy) options

which the preview is based on. However, Tonkin discloses that a print preview of a document is

generated based on configuration information which includes binding and finishing options for a

printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to

have combined the teachings of Adamske with the teachings of Tonkin because it would have

allowed a review of what the fully assembled document would like to help avoid any

miscommunications between the author and the assembler.

Regarding dependent claim 35, Adamske discloses a method in which a user uses

software on a client device to generate a print file based on a document and a print driver

(column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the

server, this print file (PostScript) being capable of being directly printed by a printer (column 5,

line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is

generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The

interface provides a preview section printing options section that allows a user to provide

configuration information including finishing and binding options that define how to assemble

the printed copies (column 7, lines 16-56 of Adamske). Adamske discloses that the user is

prompted to both configure and preview the copy of the document in the browser (column 6, line

58-column 7, line 15 of Adamske). The interface is provided to the user via the Internet for

display (column 2, lines 4-60 of Adamske). A plurality of copies are printed and assembled in

accordance with the configuration information (column 5, line 64-column 7, line 56 of

Adamske). Adamske does not directly disclose in this embodiment that a preview is generated

by the server and provided to the user based on the print file that was uploaded. However,

Adamske discloses an alternate method in which the server generates a preview based on the

print file and the configuration information and provides that preview to the user for display at

the client device (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious

to one of ordinary skill in the art to combine the two methods of Adamske because it would have

allowed the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information

obtained before the preview is generated contains finishing and binding (bound copy) options

which the preview is based on. However, Tonkin discloses that a print preview of a document is

generated based on configuration information which includes binding and finishing options for a

printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to

have combined the teachings of Adamske with the teachings of Tonkin because it would have

allowed a review of what the fully assembled document would like to help avoid any

miscommunications between the author and the assembler.

Regarding dependent claim 36, Adamske discloses that the user is prompted to both

configure and preview the copy of the document in the browser (column 6, line 58-column 7,

line 15 of Adamske). The interface is provided to the user via the Internet for display (column 2,

lines 4-60 of Adamske).

Regarding dependent claim 39, Adamske discloses a method in which a user uses

software on a client device to generate a print file and uploads it to a server or a print file may be

generated on a server based on a document and a print driver (column 5, line 64-column 7, line

15 of Adamske). Adamske also discloses a method in which a user interface is generated that

may be web based (on the server) (column 5, line 64-column 7, line 15 of Adamske). The

interface provides a preview section and a printing options section that allows a user to provide

configuration information (i.e. style options) (column 5, line 64-column 7, line 56 of Adamske).

The interface is provided to the user via the Internet for display (column 2, lines 4-60 of

Adamske). Adamske also discloses a method in which styles and printing options for the

document are obtained and shown via the preview, which is then provided to the client (column

7, lines 16-56 of Adamske).

Additionally, Adamske does not explicitly disclose that the configuration information

obtained before the preview is generated contains finishing and binding options which the

preview is based on. However, Tonkin discloses that a print preview of a document is generated

based on configuration information which includes binding and finishing options for a printed

copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It would

have been obvious to one of ordinary skill in the art at the time the invention was made to have

combined the teachings of Adamske with the teachings of Tonkin because it would have allowed

a review of what the fully assembled document would like to help avoid any miscommunications

between the author and the assembler.

Regarding independent claim 42, Adamske discloses a method in which a user uses

software on a client device to generate a print file based on a document and a print driver

(column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the

server, this print file (PostScript) being capable of being directly printed by a printer (column 5,

line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface

(configuration wizard) is generated that may be web based (on the server) (column 2, lines 4-60

of Adamske). The interface provides a preview section and a printing options section that allows

a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of

Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60

of Adamske). Adamske discloses that the user is prompted to both configure and preview the

copy of the document in the browser (column 6, line 58-column 7, line 15 of Adamske).

Adamske does not directly disclose in this embodiment that a preview is generated by the server

and provided to the user based on the print file that was uploaded. However, Adamske discloses

an alternate method in which the server generates a preview based on the print file and the

configuration information and provides that preview to the user for display at the client device

(column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of

ordinary skill in the art to combine the two methods of Adamske because it would have allowed

the client system to do less work in the process.

Additionally, Adamske does not explicitly disclose that the configuration information

obtained before the preview is generated contains finishing and binding (bound copy) options

which the preview is based on. However, Tonkin discloses that a print preview of a document is

generated based on configuration information which includes binding and finishing options for a

printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to

have combined the teachings of Adamske with the teachings of Tonkin because it would have

allowed a review of what the fully assembled document would like to help avoid any

miscommunications between the author and the assembler.

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adamske et al.

(US Patent Number 6,615,234, filed on May 11, 1999) in view of Tonkin (US Patent Number

6,134,568, filed October 30, 1998), further in view of Konica Minolta (hereinafter KM, " QMS

Printing Notes for Windows Applications," published June 20, 1995).

Regarding dependent claim 43, Adamske discloses a method in which the document

may be generated on the client and obtained from the client based on a program installed on a

client including a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske does

not explicitly disclose that an entry is added to a list of available printers for the clients in

response to installing the print driver program. However, KM discloses the notoriously well-

known teaching that when a print driver (like the PostScript driver found in the program of

Adamske) is installed an entry is added to a list of available (installed printers) for the client

(page 2, items "6." and "7." of KM). It would have been obvious to one of ordinary skill in the

art at the time the invention was made to have combined the teachings of Adamske and Tonkin

with the notoriously well known teachings of KM because it would have allowed users to easily

access previously installed printers.

(10) Response to Argument

Appellant's arguments filed 02/04/11 have been fully considered but they are not persuasive.

-Rejection of Claim 41 under 35 U.S.C. 102 (e)

Regarding Appellant's arguments on pages 9-12, in reference to independent claim 41 specifically referring to whether or not the Tonkin reference teaches concurrently displaying the different display areas in a GUI, the examiner respectfully disagrees. The limitation in question states, "...generating content for a display area of the graphical user interface, wherein the display area concurrently includes..." and then defines multiple areas which are to be included. The Tonkin reference teaches a preview area for displaying a preview of a configured copy of a document wherein the preview is based on a print file and configuration information for the document which includes at least one printing option and defines how to assemble a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of Tonkin). Tonkin discloses a navigation area that enables a user to select a portion of the preview displayed in the preview area, and a estimate area for displaying the price estimate for the configured copy based on the print file and configuration information (column 12, line 23-column 13, line 51 of Tonkin). Tonkin also discloses a configuration area which allows the user to alter the configuration information, which is automatically reflected in the preview of the document (column 7, lines 11-46 of Tonkin). The Appellant appears to be arguing that because the Figures of Tonkin show different windows for performing tasks, the windows can not be displayed concurrently. All of the elements discloses by the figures of Tonkin (specifically Figures 5, 8, and 9) are windows

that exist as a part of the main graphical user interface (column 3, lines 15-31 of Tonkin). By

definition windows are a part of a graphical user interface that encompass a portion of the screen

that allow many different items to be displayed on the screen concurrently (see the definition of

"window" provided from the Microsoft Press Computer Dictionary, published in 1993). The

Appellant is not allowed to redefine terms of the art, which includes the term "window" which is

used in the Tonkin reference in line with the definition of the term in the art. Thus, when

interpreting the term "window" in the Tonkin reference the examiner is forced to interpret it just

as it is defined.

Specifically on page 10, Appellant argues that Tonkin does not include any teaching that

the windows are arranged in such a manner to be "concurrently visible." The Examiner notes

that with regard to independent claim 41, there is no specific requirement for the claimed areas to

be "concurrently visible" but only that the display area "concurrently includes." The Examiner

notes that a reasonable interpretation/definition of the term "concurrently" is "acting in

conjunction." In view of this, clearly the multiple displayed windows of the graphical user

interface of Tonkin are included concurrently with each other to provide the all of the claimed

functionality.

-Rejection of Claims 37, 38, and 40 under 35 U.S.C. 103 (a)

A. Claim 37

Regarding Appellant's arguments on pages 12-17, in reference to independent claim 37,

Appellant argues that Adamske does not disclose a server (a) obtains document information from

a document from the system software executing on the client; (b) generates and transmits a

unique identifier for use by the system software [executing on the client]; (c) obtains the print

file from the system software executing on the client; (d) obtains a request for a configuration

graphical user interface from the client subsequent to obtaining the print file; and (e) provides the

configuration graphical user interface for display in a browser on the client in response to the

request. The Examiner respectfully disagrees with the Appellant. Adamske clearly teaches a

server (a) obtains document information from a document from the system software executing on

the client (column 3, lines 50-64: "delivery of the document"; column 5, line 64-column 7, line

15: "client...print driver program...to convert the electronic document...accomplish the

conversion and print preview functions"); (b) generates and transmits a unique identifier for use

by the system software [executing on the client] (column 5, line 64-column 7, lines 26: "creates a

metafile...a 'file cabinet'...client-side print driver program...repository of electronic

documents...previously uploaded by the user"); (c) obtains the print file from the system

software executing on the client (column 5, line 64-column 7, lines 26); (d) obtains a request for

a configuration graphical user interface from the client subsequent to obtaining the print file

(column 2, lines 4-60; column 7, 16-56); and (e) provides the configuration graphical user

interface for display in a browser on the client in response to the request (column 2, lines 4-60;

column 6, line 58-column 7, line 56: "operational screen").

Additionally, the Appellant appears to be arguing that the limitation that specifically

states, "...initiate transmitting the print file from the client to the server in response to the

generation of the print file and without user-initiated interaction the server" is not being met

because the user must send the metafile to the translation server for conversion into a printable

version (see final paragraph on page 14 of the Appellant's arguments). There are two major

flaws in the Appellant's arguments. First, the printable version of the file is created at the client

as taught by the Adamske reference. The Appellant continually argues this not to be true, yet has

made no actual persuasive response to the BPAI's decision of this teaching to be true. Thus, for

both the examiner and office's position on this the examiner recommends the Appellant consult

the decision mailed on June 18, 2008 because the examiner will not provide any further response

to this argument as the BPAI has already ruled as to the appropriate weight given any functional

component of the Adamske system regarding client and server designation as well as to the

scope of system software. Second, the Appellant believes that the transmission of the printable

file in Adamske requires "user-initiated interaction with the server," which is entirely incorrect.

The user of the client software only interacts with the client software, the actual transmission of

the file from the client to the server is done at the user's request to the client software but the user

has no actual interaction with the server (column 5, line 64-column 7, line 15 of Adamske). The

Appellant appears to be implying that the phrase "user-initiated interaction with the server"

should be interpreted as any user action, but the examiner does not have the liberty to interpret

claims outside of the broadest most reasonable interpretation, which in this case is literally the

phrase itself, with no user-initiated interaction with the server.

Appellant further argues that Adamske does not teach or suggest generating a unique

identifier for the document on the server. The Examiner respectfully disagrees with the

Appellant. Adamske teaches wherein the file name of the document was generated for uniquely

processing, storing, and locating the document and/or the corresponding print file (column 5, line

64-column 7, lines 26: "creates a metafile...contain pointers pointing to where

each…document…resides…a 'file cabinet'…client-side print driver program...repository of electronic documents…previously uploaded by the user").

B. Claim 40

In regard to claim 40, Appellant argues that Adamske fails to teach or suggest installing system software on the client, wherein the software includes at least one print driver…and an upload manager for communicating the print file from the client to the server. The Examiner respectfully disagrees. Adamske discloses a method in which a print driver is installed on the client in order to generate the print file (column 5, line 64-column 7, line 15: "returns converted printable electronic document…to web server…print driver program…sends this metafile to translation server"). Adamske discloses a method in which a print driver is installed on the client and a print file is generated using the print driver, at which point the print file is uploaded to the server (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which the print driver necessary is automatically selected (column 5, line 64-column 7, line 15 of Adamske).

-Rejection of Claims 12-16, 20-27, 31-36, 39, and 42 under 35 U.S.C. 103 (a)

A. Claim 12

Regarding Appellant's arguments on pages 18-21, in reference to independent claim 12 specifically referring to whether or not the Adamske reference teaches the first limitation of the claim, the examiner respectfully disagrees. Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a print driver

(column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the

server, this print file (PostScript) being capable of being directly printed by a printer (column 5,

line 64-column 7, line 15 of Adamske). The arguments here are based on the same principles as

independent claim 37, the print file is not generated at the client and the phrase "user-initiated

interaction with the server" has a different meaning than the actual phrase itself. Once again,

there are two major flaws in the Appellant's arguments. First, the printable version of the file is

created at the client as taught by the Adamske reference. The Appellant continually argues this

not to be true, yet has made no actual persuasive response to the BPAI's decision of this teaching

to be true. Thus, for both the examiner and office's position on this the examiner recommends

the Appellant consult the decision mailed on June 18, 2008 because the examiner will not

provide any further response to this argument as the BPAI has already ruled as to the appropriate

weight given any functional component of the Adamske system regarding client and server

designation as well as to the scope of system software. Second, the Appellant believes that

"user-initiated interaction with the server," is required in Adamske which is entirely incorrect.

The user of the client software only interacts with the client software, the actual transmission of

the file from the client to the server is done at the user's request to the client software but the user

has no actual interaction with the server only with the client software (column 5, line 64-column

7, line 15 of Adamske). The Appellant appears to be implying that the phrase "user-initiated

interaction with the server" should be interpreted as any user action, but the examiner does not

have the liberty to interpret claims outside of the broadest most reasonable interpretation, which

in this case is literally the phrase itself, with no user-initiated interaction with the server. Thus,

once again the rejection is proper and must be maintained.

B. Claims 32 and 33

In regard to dependent claims 32 and 33, Appellant argues that Adamske and Tonkin each fail to teach or suggest that the print file can be directly printed by a printer or that the print file comprises one of a Postscript file and a Portable Document format (PDF) file. The Examiner respectfully disagrees. The Adamske reference clearly teaches wherein the print file could be directly printed to a printer in the form of a PostScript file (column 5, line 35-column 7, line 15: "opens this client application...opens the electronic document using the client application, converts the electronic document into a printable (e.g., PostScript) format file...conversion into a printable...version"). While not relied upon, the Tokin reference also teaches said feature (column 7, lines 11-27: "PDF...first convert them into a portable document format").

C. Claim 13

In regard to dependent claim 13, Appellant argues that Adamske and Tonkin each fail to teach or suggest installing at least one print driver for generating the print file on the client. The Examiner respectfully disagrees and notes that Adamske clearly teaches said feature (column 5, line 64-column 7, line 15: "print driver program can be downloaded on the client...conversion into a printable (e.g. Postscript) version").

D. Claim 14

In regard to dependent claim 14, Appellant argues that Adamske and Tonkin each fail to teach or suggest generating the print file on the client using one of the at least on print driver in

response to the request, and transmitting the print file to the server over the network in response

to the generating. The Examiner respectfully disagrees and notes that Adamske discloses a

method in which a print driver is installed on the client and a print file is generated using the

print driver, at which point the print file is uploaded to the server (column 5, line 64-column 7,

line 15 of Adamske). Adamske further discloses prompting the user to configure and preview

the bound copy of the document (column 5, line 64-column 7, line 15: "print driver program thus

includes all the functionality of the print preview software...operational screen...select media

options...handling options").

E. Claim 20

In regard to dependent claim 20, Appellant argues that Adamske and Tonkin each fail to

teach or suggest a component configured to preview a document over a network by providing the

system software as claimed. Appellant's arguments fail to comply with 37 CFR 1.111(b)

because they amount to a general allegation that the claims define a patentable invention without

specifically pointing out how the language of the claims patentably distinguishes them from the

references. Regardless, the Examiner respectfully disagrees and notes that the claims incorporate

substantially similar subject matter to previously addressed claims 12-15. Thus, the claims

remain rejected along the same rationale as claims 12-15.

F. Claim 22

In regard to dependent claim 22, Appellant argues that Adamske and Tonkin each fail to

teach or suggest a local application that generates the document, displays the list of available

printers and enables a user to select the print driver from the list of available printers. The

Examiner respectfully disagrees. Adamske discloses a method in which a print driver is installed

on the client and a print file is generated using the print driver, at which point the print file is

uploaded to the server (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a

method in which the print driver necessary is automatically selected (column 5, line 64-column

7, line 15 of Adamske). Adamske does not disclose a method in which the print driver is listed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to have allowed to have listed the print driver of Adamske because it would have allowed the

user to see the format type the print file would be in.

G. Claim 24

In regard to independent claim 24, Appellant argues that Adamske and Tonkin each fail

to teach or suggest a component configured to print a document over a network by providing the

system software as claimed. Appellant's arguments fail to comply with 37 CFR 1.111(b)

because they amount to a general allegation that the claims define a patentable invention without

specifically pointing out how the language of the claims patentably distinguishes them from the

references. The Examiner respectfully disagrees and notes that Appellant's arguments are

substantially similar to those presented with regard to other independent claims. Thus the claim

remains rejected along the same rationale as shown above in the rejection and discussed above in

the arguments.

H. Claim 31

In regard to independent claim 31, Appellant argues that Adamske and Tonkin each fail to teach or suggest program code for enabling a computer system to print a document over a network by providing the system software as claimed. Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The Examiner respectfully disagrees and notes that Appellant's arguments are substantially similar to those presented with regard to other independent claims. Thus the claim remains rejected along the same rationale as shown above in the rejection and discussed above in the arguments.

I. Claim 39

In response to Appellant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and KSR International Co. v. Teleflex, Inc., 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, Adamske discloses a method in which styles and printing options for the document are obtained and shown via the preview, which is then provided to the client (column 7, lines 16-56 of Adamske). However, Adamske does not explicitly disclose that the configuration information obtained before the preview is generated contains finishing and

binding options which the preview is based on. Tonkin discloses that a print preview of a

document is generated based on configuration information which includes binding and finishing

options for a printed copy of the document (column 2, lines 24-61 and column 7, lines 11-46 of

Tonkin). It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have combined the teachings of Adamske with the teachings of Tonkin because it

would have allowed a review of what the fully assembled document would like to help avoid any

miscommunications between the author and the assembler.

J. Claim 42

In regard to independent claim 42, Appellant argues that Adamske and Tonkin each fail

to teach or suggest program code for enabling a computer system to preview a document by

generating a print file on a client, transmitting the print file from the client to a server without

user-initiated interaction with the server, and prompting the user to configure and preview a

bound copy of the document. Appellant's arguments fail to comply with 37 CFR 1.111(b)

because they amount to a general allegation that the claims define a patentable invention without

specifically pointing out how the language of the claims patentably distinguishes them from the

references. The Examiner respectfully disagrees and notes that Appellant's arguments are

substantially similar to those presented with regard to other independent claims. Thus the claim

remains rejected along the same rationale as shown above in the rejection and discussed above in

the arguments.

-Rejection of Claim 43 under 35 U.S.C. 103 (a)

In regard to claim 43, Appellant argues similarly to arguments presented above with respect to claim 42. The Examiner respectfully disagrees with the Appellant and points to the above rationale wherein the arguments have previously addressed.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and

Interferences section of this examiner's answer are provided herein by the Appellant.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Adam L Basehoar/

Primary Examiner, Art Unit 2178

Conferees:

/Stephen S. Hong/

Supervisory Patent Examiner, Art Unit 2178

Stephen Hong, Supervisory Patent Examiner AU 2178

William Bashore, Supervisory Patent Examiner AU 2175

/William L. Bashore/

Supervisory Patent Examiner, Art Unit 2175